

REMARKS

In the Office Action mailed January 9, 2006, all of the claims in this application have been rejected as unpatentable under 35 U.S.C. § 103(a) over the Miracle et al. U.S. Patent No. 5,576,282 (Miracle et al. '282) in view of Perkins U.S. Patent No. 4,153,968 (Perkins '968 patent) and further in view of the McAllise et al. U.S. Patent No. 5,500,977 (McAllise et al. '977). This rejection is respectfully traversed.

The Miracle et al. '282 patent has been the subject of a great deal of discussion in the record of this application. The disclosure in the Miracle et al. '282 patent is not in dispute.

The Perkins '968 patent discloses an extraction cleaning machine for use in cleaning carpeting, upholstery and similar materials of the type used in the interior of automobiles, trucks, buses, campers, boats, aircraft, and other like vehicles. It includes a detergent tank, a source of water supply, a heating element, a recovery tank and a hose with a suction nozzle and a spray nozzle. Water from a domestic water supply is connected to a reservoir which contains the heater and heats the water therein to a temperature of about 180° F. Heated water is fed to the spray nozzle for depositing on the floor and alternatively is recirculated back to the reservoir. A detergent tank is connected to the return line for the water and is admixed with the return water, thereby adding detergent to the reservoir. Perkins '968 further discloses that multiple detergent tank can be included in the extractor for use *alternatively* under different conditions.

The McAllise et al. '977 reference discloses an upright carpet extractor in which a handle is pivotally mounted to a base. The handle mounts a detergent tank which is fluidly connected to a distributor on the base for distributing cleaning fluid to a floor surface. The base also includes a suction nozzle which is fluidly connected to a recovery tank mounted on the base. A motor mounted on the base has a fan which is connected to the suction nozzle and the recovery tank for drawing soiled fluid and air from the suction nozzle to the recovery tank wherein the fluid is separated from the air. The air is then drawn from the recovery tank through a motor fan and then to the distributor for aspirating the detergent. McAllise et al. '977 discloses that "warm, moist exhaust air, from motor fan '610, is discharged through discharged nozzle 65 and directed toward the surface being cleaned."

There is no disclosure in McAllise et al. '977 of heating the air. The air which is exhausted from the motor fan 610 is ambient air which has been sucked through the suction nozzle in the base and then passed through the recovery tank. If the air is warm, it can essentially be no warmer than ambient air which is drawn in through the suction nozzle. If the air that is exhausted from the motor fan 610 is under pressure, the air will be cooled when it expands as it passes through a discharge nozzle 65. Thus, the air that passes through the discharge nozzle 65 and atomizers the cleaning fluid is not heated. If there is any evaporation of the cleaning fluid due to the atomization process, then the cleaning fluid will be further cooled. In any case, the air from the motor fan 610 in the McAllise et al. '977 reference cannot heat the cleaning solution. The Examiner should also note that the cleaning fluid in the cleaning fluid supply tank of McAllise et al. '977 is likely at or above ambient air temperature if hot water is added to the detergent tank and therefore cannot be heated by the exhaust air from the motor fan 610.

The alleged combination of Miracle et al. '282 with Perkins '968 and McAllise et al. '977 is traversed. There is no basis for making the alleged combination of references.

The Examiner has not shown any basis for making the alleged combination of references but merely has pulled disclosures from each of the references and concluded, illogically, that the alleged combination of disclosures can be made.

The Board, in its decision, held that the disclosure in Miracle et al. '282 could be combined with a carpet cleaning machine. Thus, the Examiner's combination of Miracle et al. '282 and Perkins '968 would appear to be supported by the Board's decision. However, the alleged combination of Miracle '282 and Perkins '968 with McAllise et al. '977 has not been shown by the Examiner and is believed inappropriate.

There is no credible support in any of these references which would support the alleged combination of Miracle '282 and Perkins '968 with McAllise et al. '977. The rules for the combinability of prior art references is discussed in detail by the United States Court of Appeals for the Federal Circuit in Ecolochem, Inc. v. Southern California Edison Co., Case 99-1043 decided September 7, 2000, 227 F.3d. 1361; 56 USPQ2d 1065,

(<http://www.ll.georgetown.edu/Fed-Ct/Circuit/fed/opinions/99-1043.html>) at 1371-1372 in which the Court stated:

Our case law makes clear that the best defenses against hindsight-based obviousness analysis is *the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references*. See Demibiczak, 174 F.3d at 999, 50 USPQ2d at 1617. "*Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essences of hindsight.*" Id.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Roufet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The same principle applies to invalidation. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," Monarch Kitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040 1042 (Fed. Cir. 1992) (quoting Lindemann, 730 F.2d at 1462, 221 USPQ at 488). (Emphasis added.)

The Examiner has erred in attempting to use Applicants' disclosure as a blueprint for hindsight-based arguments and has not comported with the standards of the United States Court of Appeals for the Federal Circuit.

See also In re Sang-Su Lee, 00-1158, decided January 18, 2002, 277 F.3d 1338; 61 USPQ2d (BNA) 1430 (<http://www.ll.georgetown.edu/Fed-Ct/Circuit/fed/opinions/00-1158.html>) at pages 1342-1344.

Like the Examiner in *In re Sang-Su Lee*, the Examiner has not adequately addressed the issue of motivation to combine the references. Simply pointing out Applicants' disclosed solution to a problem or some speculative beneficial result of the combination does not meet the requirement of motivation to combine the references. These conclusive statements are not factual evidence of motivation that can be drawn from the cited references.

There is no disclosure as to how one would use the fluid distribution system of McAllise et al. '977 in the Perkins '968 extractor. The Examiner's combination is purely speculative.

However, even if the alleged combination of Miracle '282, Perkins '968 and McAllise et al. '977 were to be made, however untenably, it still would not reach Applicants claimed invention. The alleged combination would simply provide the exhaust from the suction motor of Perkins '968 to the fluid distribution system for atomizing the fluid distribution at the floor nozzle. This alleged combination would not reach Applicants' claimed invention.

There are two independent claims in the application; claim 18 and claim 21. Claim 18 distinguishes over the Examiner's alleged combination in calling for the step of mixing the admixture (of oxidizing agent with the cleaning solution) with heated air to heat the admixture. This step is not disclosed in the Examiner's alleged combination of Miracle '282 and Perkins '968 with McAllise et al. '977 because there is no teaching of heating an oxidizing agent and cleaning solution with heated air. Further, claim 18 distinguishes over the Examiner's alleged combination of Miracle '282 and Perkins '968 with McAllise et al. '977 in calling for the step of heating the air before the step of mixing the admixture with the heated air.

The Examiner's alleged combination of Miracle '282 and Perkins '968 with McAllise et al. '977 has no disclosure of heating air before the step of mixing the admixture with heated air.¹

As pointed out above, the McAllise et al. '977 patent does not disclose the step of heating air before admixing the heated air with an admixture of an oxidizing agent and a cleaning solution.

¹ The Board of Patent Appeals and Interferences apparently misunderstood Applicants disclosure on page 27 of the specification. The Board apparently mistakenly believed that McAllise et al. '977 discloses the step of heating air from the motor fan before mixing air with the detergent. What is disclosed on page 27 of the specification is the use of air from a motor fan, such as disclosed in McAllise et al. '977, with a heater *which is not disclosed* in McAllise et al. '977 to heat the admixture of detergent and oxidizing agent before the detergent is distributed to the floor.

Thus, claim 18 and the claims dependent therefrom patentably define over any alleged combination of Miracle et al. '282, Perkins '968, and McAllise et al. '977.

Claim 21 defines over the Examiner's alleged combination of Miracle '282 and Perkins '968 with McAllise et al. '977 in calling for the step of heating the cleaning solution before admixing oxidizing agent with the cleaning solution. The alleged combination of Miracle et al. '282, Perkins '968, and McAllise '977 does not meet this limitation. At best, the Miracle composition would be deposited in the solution tank 114 of Perkins '968. Although Perkins discloses that more than one detergent tank can be employed, any additional detergent tank would be employed *alternatively* and not sequentially. Further, there is no teaching of heating a detergent composition *before* adding an oxidizing composition to the heated solution.

The Examiner has apparently ignored the Board's decision with respect to claim 21. The Board held that the Examiner's combination of Miracle et al. '282 with Ligman or Sham did not disclose "the step of heating the cleaning solution before the admixing step to heat the admixture as recited in claim 21." See page 7 of the Board decision. The Examiner should also recognize that the Board's footnote on page 7 of its opinion did not refer to claims 11, 17, and 21 but rather referred to claims 8, 14, and 18. Thus, the Examiner's rejection of claim 21 and the claims dependent therefrom is contrary to the law of the case. Although the Perkins '968 reference was not combined with Miracle in the previous rejection of claim 21, the Examiner's combination of Miracle et al. '282 and Perkins '968 is essentially the same for purposes of the current rejection of claim 21 as the combination of Miracle et al. '282 with Ligman or Sham. Thus, it is believed that the Examiner's rejection of claim 21 and the claims dependent therefrom are in error in view of the Board's decision on claims 11, 17 and 21.

Furthermore, claim 8 depends from claim 21 and calls for the step of heating air before the step of mixing the admixture with heated air. As set forth above, this concept is not disclosed in the alleged combination of Miracle et al. '282, Perkins '968, and McAllise et al. '977.

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Examiner: Necholus Ogden Jr.
Group Art Unit: 1751

DOUBLE PATENTING

All of the claims in this application have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of 16-25 and 46-69 of co pending application number 10/904,054 and 10/710,776, respectively. This rejection is respectfully traversed.

The provisional rejection on the ground of nonstatutory obviousness-double patenting is premature because the cited co-pending applications have not even been acted on. Further, the co-pending applications were filed well after the filing date of the current application. Still further, the claimed subject matter of the two cited pending applications are unrelated to the claimed subject matter of this application other than they relate to extraction, and in one case relate to heating. Otherwise, there is not relationship between the applications. The examiner is invited to point out the overlap in claimed subject matter in these two pending applications in more detail if this rejection is to be continued.

If and when the Examiner finds allowable subject matter in the present application, and allowable subject matter is found in the claims 13-25 and 46-69 in the co-pending applications, Applicants will consider the Examiner's obviousness-type double patenting rejection. At the present time it is premature and inappropriate.

In view of the foregoing, it is submitted that all of the claims in the application are in condition for allowance. Early notification of allowability is respectfully requested.

Respectfully submitted,

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